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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,576

11/09/2001

Robert J. Greenberg

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09/15/2008

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EXAMINER

OROPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3766

MAIL DATE

DELIVERY MODE

09/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/033,576	Applicant(s) GREENBERG ET AL.	
	Examiner FRANCES P. OROPEZA	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/20/08 (Response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 271,332-337 and 340 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 271,332-337 and 340 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/10/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

1. The Applicant's arguments in the response filed 5/20/08 have been fully considered and are convincing, hence the rejection of record is withdrawn and a new rejection established in the subsequent paragraphs.

Claim Rejections - 35 USC § 102

2. Claims 271, 332 and 340 are rejected under 35 U.S.C. 102(b) as being anticipated by de Juan, Jr, et al. (U.S. Patent No. 5,109,844). Substantially teaching the instant invention, de Juan, Jr, et al. disclose an electrode array (microstimulator – figure 6 - 50) with insulation (figures 1, 3 - 35), voids and a plurality of electrodes (figure 3 - 24, 31) recessed and exposed in more than one dimension, the x and y planes, this configuration forming capacitors with the retina (figures 1, 3, 6; column 4, lines 25 – 27; column 5, lines 63-68).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 333-337 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Juan, Jr. et al. (U.S. Patent No. 5,109,844) in view of Byers et al. (U.S. Patent No. 4,969,468).

As discussed in paragraph 2 of this action, de Juan, Jr. et al. disclose the claimed invention except:

- the plurality of electrodes having different lengths (claim 333),
- the plurality of electrodes having a spike-shaped (claim 334),
- an integrated circuit (claim 335),
- the array body having a generally curved surface on at least one side (claim 336), and
- the electrodes being metal and at least partially coated in ceramic (claim 337).

Byers et al. teaches electrode array configurations using a plurality of spike-shaped electrodes (Figure 6 – 12, 13; Figure 11 – 31, 32) being metal and at least partially coated in ceramic (Figure 7; col. 6 @ 63-68), and having different lengths (Figure 11 – 31, 32), the electrode array body comprising an integrated circuit (Figure 6 – 7; col. 10 @ 29-30; Figure 12 – 33-38; col. 7 @ 63-66), and having a generally curved surface on at least one side (col. 10 @ 17-20) for the purpose of having optimally designed metal electrodes whose spiked-shape, varying

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lengths, and ceramic coating allows the stimulation to be directed toward the targeted tissue in the retina for the purpose of creating a focus electrical stimulus, the electrode stimuli optimally controlled with proven control technology, an integrated circuit, and the array body having a generally curved-shaped body to conform to the retina to effectively and optimally contact and stimulate the retinal tissue. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a plurality of spike-shaped metal electrodes, at least partially coated in ceramic and having different lengths, and an electrode array body comprising an integrated circuit and having a generally curved surface on at least one side in the de Juan, Jr. et al. system in order to customize the stimulation device for the specific patient needs so stimulation of the retina tissue in that specific location enables the patient to gain an optimal degree of sight while not penetrating the retinal basement membrane at the surface of the retina, hence avoiding mechanical damage to the cell of the retina and the ganglion cell at the surface thereof (column 1, line 67 – column 2, line2; column 2, lines 10-13).

Statutory Basis

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Carl. H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM–5 PM EST; Tuesday, Thursday 9AM–3PM and 9PM–11PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/
Patent Examiner, Art Unit 3766
September 12, 2008

/Carl H. Layno/
Supervisory Patent Examiner, Art Unit 3766